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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,298	05/03/2001	Christian Walsdorff	51416	5427

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EXAMINER

JOHNSON, EDWARD M

ART UNIT PAPER NUMBER

1754

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,298

Applicant(s)

WALSDORFF ET AL.

Examiner

Edward M. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5,6,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,6,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this .

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-3, 5-6, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courty et al. US 4,381,415 in view of Petit et al. US 5,972,827.

Regarding claim 12, Courty '415 discloses a catalyst comprising delta alumina carrier (see column 3, lines 55-60), which would be a detectable amount, since it is specifically disclosed.

Courty fails to disclose a powder.

Petit '827 discloses a powder.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the powder form of Petit in the oxychlorination catalyst of Courty because Petit discloses the powder form for an oxychlorination catalyst

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(title), wherein the performance of the catalyst is maintained constant over time (see column 2, lines 32-35).

Regarding claim 2, Courty '415 specifies the carrier selected from eta, gamma, chi, kappa, theta, delta, or rho alumina (see column 3, lines 55-60).

Regarding claims 3 and 13, Courty '415 discloses 0.05-0.6% copper and 0.1-1% potassium (see column 3, lines 34-38), either of which would be obvious for an ordinary artisan to modify to affect the disclosed catalytic result.

Regarding claims 5-6, Courty '415 discloses impregnation of the active elements on carrier (see column 3, lines 64-68) and copper chloride (see Example 3).

3. Claims 2-3, 5-6, and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Convers et al. US 4,460,699 in view of Petit '827.

Regarding claim 12, Convers '699 discloses an oxychlorination catalyst comprising a gamma, eta, or delta alumina carrier (see column 4, lines 51-61), which would be a detectable amount, since it is specifically disclosed.

Convers '699 fails to disclose a powder.

Petit '827 discloses a powder.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the powder form of

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Petit in the oxychlorination catalyst of Convers because Petit discloses the powder form for an oxychlorination catalyst (title), wherein the performance of the catalyst is maintained constant over time (see column 2, lines 32-35) and Convers discloses many known fluidized bed processes (see background), which would further lead an ordinary artisan to combine the cited references.

Regarding claim 2, Convers '699 discloses about 17.1% and 22.6% of the catalyst (see Examples 3-4).

Regarding claims 3 and 13, Convers '699 discloses 1-7 percent copper (see column 5, lines 25-26), lithium, sodium, potassium, rubidium, or cesium on a 0.05 to 1.0 molar basis relative to copper (see column 5, lines 29-35), and a surface area of 100-200 square meters per gram (see column 4, lines 62-66), either of which would be obvious for an ordinary artisan to modify to affect the disclosed catalytic result.

Regarding claims 5-6, Convers '699 discloses impregnating 1-7 percent copper (see column 5, lines 25-26 and Example 1), lithium, sodium, potassium, rubidium, or cesium on a 0.05 to 1.0 molar basis relative to copper using copper chloride (see column 5, lines 29-35 and Examples), and a surface area of 100-200 square meters per gram (see column 4, lines 62-66).

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4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Courty '415 in view of Petit '827 and Convers '699.

Courty '415 discloses a catalyst comprising delta alumina carrier (see column 3, lines 55-60), which would be a detectable amount, since it is specifically disclosed and 0.1-1% potassium (see column 3, lines 34-38).

Courty fails to disclose a powder.

Petit '827 discloses a powder.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the powder form of Petit in the oxychlorination catalyst of Courty because Petit discloses the powder form for an oxychlorination catalyst (title), wherein the performance of the catalyst is maintained constant over time (see column 2, lines 32-35).

Courty discloses 0.05-0.6% copper. However, Convers '699 discloses impregnating 1-7 percent copper.

It would have been obvious to use the 1-7% copper of Convers with the oxychlorination catalyst of Courty because Convers discloses the copper for oxychlorination requiring less active catalytic material per gram, which would lead an ordinary artisan to optimize the copper to an amount including between 1-7%.

Response to Arguments

5. Applicant's arguments filed 1/25/06 have been fully considered but they are not persuasive.

It is argued that in this case, there is no motivation to combine the references. This is not persuasive because Courty does not disclose a "fixed bed", as Applicant asserts, and Convers discloses many known fluidized bed processes (see background), which would further lead an ordinary artisan to combine the cited references. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to use the powder form of Petit in the oxychlorination catalyst of Courty and/or Convers because Petit discloses the powder form for an oxychlorination catalyst (title), wherein the performance of the catalyst is maintained constant over time (see column 2, lines 32-35) and and Convers discloses many known fluidized bed processes (see background), which would further lead an ordinary artisan to combine the cited references.

It is argued that moreover, Convers et al. states... fixed bed process. This argument is not persuasive because it is not commensurate in scope with the claims, since Applicant does not claim a specific particle size. It is noted that the features upon which applicant relies (i.e., a catalyst having a specific particle size) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is also noted that Convers does not "teach away" from the cited combination, as Applicant asserts, since Convers does not specifically teach that such sizes, much less "powders" (as claimed) should be avoided.

It is argued that in contrast to Convers et al. and Courty... fluidized bed systems. This is not persuasive for the reasons above.

It is argued that the respective advantage of Petit et al... fixed to fluidized. This is not persuasive because the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

It is argued that furthermore, Petit et al... alumina in powdered form. This is not persuasive because it would have been obvious to use any alumina, including delta alumina, to one of ordinary skill and also because Petit is not relied upon for such a disclosure, since Courty '415 specifies the carrier selected from eta, gamma, chi, kappa, theta, delta, or rho alumina (see column 3, lines 55-60) and Convers '699 discloses an oxychlorination catalyst comprising a gamma, eta, or delta alumina carrier (see column 4, lines 51-61). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman

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can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.



Edward M. Johnson
Primary Examiner
Art Unit 1754

EMJ